

Serial No. 10/751,009
Docket No. SHE0074.00

REMARKS


I. The Restriction Requirement:

The Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- I. Claims 35-53, drawn to a polymeric reagent (classified in class 424, subclass 78.27); and
- II. Claims 170-182, 184 and 187-188, drawn to a method for making a polymer-active agent conjugate (classified in class 424, subclass 486).

The Examiner has further required election of a single disclosed species under 35 U.S.C. §121 requiring Applicants to name a specific cyclic group with a specific functional group, a specific polyethylene glycol¹ (branched or unbranched), a specific R⁷ group, and a specific type of active agent.

II. Response to the Restriction Requirement:

In response, Applicants hereby elect Group I, claims 35-53, *with traverse*. In addition, Applicants hereby elect the following species: a polymeric reagent comprising a keto-piperidinyl group (i.e., , as the specific cyclic group with a specific functional group), a linear polyethylene glycol (as the specific polyethylene glycol), and a methyl (as a specific R⁷). No election of a specific active agent is made as none of the claims in Group I recites the feature of an active agent. The claims that are readable on this election include claims 35, 36, 38, 39, 41-45, and 47-49, 52 and 53.

Traverse is premised on the ground that a combined search of both Group I and Group II does not impose an undue burden on the Examiner. As stated in the Manual of Patent Examining Procedure ("MPEP"),

¹ Although Applicants note that claim 35 (the only independent claim of Group I) encompasses water-soluble polymer segments other than a poly(ethylene glycol), Applicants have preserved use of the term "polyethylene glycol" in this Response for the purpose of maintaining consistency with the term adopted by the Examiner. Applicants, however, reserve the entire scope of the "water-soluble polymer segment" term in the claim.

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[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

See M.P.E.P. Section 803.

Here, both Group I and II have been assigned to the same classification (i.e., class 424), thereby suggesting that a search of potential art in this classification is simultaneously useful for each Group. In view of the above, it is therefore believed that search and examination of the entire application can be made without serious burden to the Examiner. Consequently, reconsideration and removal of the requirement for restriction are respectfully requested.

In addition, with respect to the requirement to elect a specific species, Applicants emphasize that the independent claim appears to be easily searched to thereby narrow the amount of relevant prior art the Examiner must consider. In this way, the Examiner should be able to identify any relevant prior art for the entire scope of the elected Group and not simply for the elected species.

Finally, Applicants emphasize that election of the species is for initial search purposes only and that Applicants will be entitled to consideration of additional species upon the allowance of a generic claim as provided by 37 C.F.R. §1.141.

III. Conclusion:

In view of the foregoing, Applicants submit that the all of pending claims satisfy the requirements of patentability and are therefore in condition for allowance. Consequently, a prompt mailing of a Notice of Allowance is earnestly solicited.

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If a telephone conference would expedite the prosecution of the subject application, the Examiner is requested to call the undersigned at (650) 620-5506.

Respectfully submitted,
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Date: May 15, 2006

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